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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/686,880	10/12/00	SMITH	A 06999.0009

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HM12/0424

EXAMINER

KATCHERES, K

ART UNIT	PAPER NUMBER
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1636

DATE MAILED:

04/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/686,880

Applicant(s)

SMITH ET AL.

Examiner

Konstantina Katcheves

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-41 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☒ Other: *detailed action*.

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***Election/Restriction***

Claims 1-20 and 22-41 are pending in the instant action.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, 23-26 and 32-33, drawn to a method of generating a culture, classified in class 435, subclass 325.
- II. Claims 18-20, drawn to a composition of cells, classified in class 435, subclass 372.
- III. Claims 22, 27 and 28, drawn to an assay, classified in class 530, subclass 350.
- IV. Claims 29-31, 34 and 35, drawn to isolated neural progenitor cells, classified in class 435, subclass 368.
- V. Claim 36, drawn to a method of treatment of neurodegenerative disease, classified in class 514, subclass 2.
- VI. Claims 37-41, drawn to a method of amplifying a population of progenitor cells, classified in class 435, subclass 385.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV, V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions relate to different methods and products.

Groups I, ~~II~~<sup>III</sup>, V and VI relate to various methods: Group I relates to a method of generating a culture, Group III relates to an assay for the activity of compositions, Group V relates to a method of treatment, and Group VI relates to a method of amplifying cells. Each of

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these methods have different functions and effects. In order for each of these methods to perform the function intended, different method steps are invariably required. For example, the steps required for the treatment of disease is inherently different from an assay or the culturing or amplification of cells. Therefore, the above methods are distinct from each other.

Groups II and IV relate to compositions. Group II relates to a composition of cells while Group IV relates to isolated neural progenitor cells. Group II is not related to Group IV because a composition of neural progenitor cells specifically relates to a certain cell type with specific functions and cellular attributes that define them. A composition of any progenitor cells claimed as in Group II can relate to many different types of progenitor cells with functions and attributes clearly different from neural progenitor cells.

Each of the compositions of Groups II and IV are different from each of the methods of Groups I, III, V and VI. Unless otherwise related, compositions and methods are separate and distinct from each other. The compositions of Groups II and IV are not necessarily capable of being used with the methods disclosed. The methods of amplification and culture of Groups VI and I may be used for other types of cells than those of Groups II and IV. Additionally absent any indication to the contrary, the method of treatment of Group V and the assay of Group III, do not necessarily require the cells of Groups II or IV for the practice of their invention. The methods also have different functions and effects rendering them separate and distinct inventions.

These inventions have acquired a separate status in the art as shown by their different classification such that restriction for examination purposes is proper. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of

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their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konstantina Katcheves whose telephone number is (703) 305-1999. The examiner can normally be reached on Monday through Friday 7:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader can be reached on (703) 308-0447. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 305-7939 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3388.

Konstantina Katcheves  
April 9, 2001

  
ANDREW WANG  
PATENT EXAMINER  
TC 1600